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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/734,694	12/13/2000	Rayi Ganesan	23952-0138	6528
72386 7590 05/26/2009 SUTHERLAND II SUTHERLAND, ASBILL & BRENNAN, LLC 999 PEACHTREE STREET ATLANTA, GA 30309				
EXAMINER COLBERT, ELLA				
ART UNIT 3696		PAPER NUMBER		
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

09/734,694

**Applicant(s)**

GANESAN, RAYI

**Examiner**

Ella Colbert

**Art Unit**

3696

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 January 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 60-99 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 60-99 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 December 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/C)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date 05/15/08

### **DETAILED ACTION**

1. Claims 60-99 are pending. Claims 1-59 have been cancelled after an Election/Restriction with traverse and claims 60-99 are new claims filed 01/12/09 entered as Preliminary Amendment.
2. The IDS filed 05/15/08 has been entered and considered.

### ***Specification***

The abstract of the disclosure is objected to because Page 1 of the specification recites "to information available on Internet, a World Wide Web has been". This should recite "to information available on the Internet, a World Wide Web has been". Page 7, line 2 recites "frame processor. The memory also may be type memory capable of". This line should recite "frame processor. The memory also may be a type of memory capable of". Correction is required. See MPEP § 608.01(b).

### ***Drawings***

The drawings are objected to because Fig. 1 has the application stamp in part of the drawing and there is not enough margin on the left side and at the top of the drawing figure; Fig.'s 2 and 3 do not have enough margin at the top; Fig.'s 13 and 25 do not have enough margin on the left side of the drawings. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the

appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: Fig. 1, reference elements 140B3-140B5; 140B6-140B7; programmed instructions 140B1; and relational database 140B2 are missing from the drawing; Fig. 2, reference numbers 140, 140B1; 140B2, 110H, 110D, 110A, and 110C; Fig. 4, reference elements 140, 140B2, and 100; Fig. 6, 140, 140B2, and 100; Fig. 9, 140B; Fig. 10, database 140; Fig. 11, 140 Central Clearinghouse Station and 140 Central Station; Fig. 12, Step 325 of Fig. 3 not mentioned prior to Fig. 13; Fig. 14, "To Step 322 of Fig. 3; Fig. 19, 1915A-1915C, 1920A-1920D; Fig. 20, 2000; Fig. 21, 2100 and 2300 not determined in Specification; Fig. 26, 1715 and 1710; Page 38, Steps 2202-2209, 2211-2219, 2302-2309, 2311-2314, 2611-2614, 2616-2619, 2621-2624, and Database 1407; Fig. 25, 110B, 1601-1603, and 2555 are missing from the Specification. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to

avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: Fig. 2 reference elements "235, 225," and "285"; Fig. 4, reference elements 230, 235, 222, 210A, 210B, 240, 260, 225, 285, 280, 205, 265, 255, 250, 275, 245, 110H, 130A, 270, and 130C are not mentioned except to state that Fig. 4 is similar to Fig. 2; Fig. 6, 140B and 110F; Fig. 8, 140, 140B2, 100, 140B3, 140B4, 140B5, 825, Central Processor 140A and Central Station 140A; Fig. 13, database 140B5; Fig. 15, reference element 140B; Fig. 16, reference elements 140B and 110B; Fig. 17, reference element 140B6; Fig. 20, reference element 110B not in drawing Fig. 19 or Fig. 20; Fig. 21, reference element 2101; Fig. 22, Database 140B6; Fig. 23, Database 140B6 , 140B5, Database 140B2, 140B3, and 140B4; Fig. 24, Database 140B3 and 140B6; Fig. 25 and Fig. 26, 140B3 and 140B6, Fig. 26, 2610-2625, 140B7; Fig. 28 recites "Following Step 1706 is in the Specification but the drawing recites "From Step 1701 of Fig. 17; Fig. 28, reference elements 140B3 and 140B7; Fig. 32, Database 140B2, 140B5, and 140B4 are missing from the drawings. Corrected drawing sheets in

compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Objections***

Claims 61 and 97 are objected to because of the following informalities: Claim 61 recites "determining, subsequent to the matching, whether a bill presentment information is". This line should recite "determining, subsequent to the matching, whether bill presentment information is". Claim 97 recites "the at least one processor is ... communications interface to and". This line should recite "the at least one processor is ... communications interface to". Appropriate correction is required.

Claims 61, 62, 77, 78, 80, 81, 96, and 97 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 60, 69, 71, 73, 79, 88, 90, 92, and 99 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 60 recites "intend" which is not a positive recitation. "Intend is defined as "to have in mind; plan". It does not mean that the act will be performed. Claims 79 and 99 have a similar problem. Claim 60 also recites "accessing, by the clearinghouse and based on at least a portion of the received information identifying the payee, at least one database containing billing information;". This claim limitation is vague and indefinite as written. Does Applicant mean "accessing, by the clearinghouse and based on at least a portion of the received information identifying the payee, in at least one database containing billing information;"? Claims 73, 79, and 92 have a similar problem. Claim 69 recites "identifying, by the clearinghouse, second information identifying the payee". It is unclear how there can be second information when nothing has been mentioned about first information in the body of the claim. First bill information appears to be only in the preamble of the claim. Claims 71, 73, 88, 90, and 92 have a similar problem.

Claim 99 recites "adapted to" which is one of the following examples of language in a claim that may raise a question as to the limiting effect of the language in a claim are: (A) statements of intended use or field of use, (B) "adapted to" or "adapted for"

clauses, (C) "wherein" clauses, or (D) "whereby" clauses. The list of examples is not intended to be exhaustive." MPEP 2106 II C.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 60-99 are rejected under 35 U.S.C. 103(a) as being unpatentable over (US 5,884,288) Chang et al, hereafter Chang in view of (US 6,173,272) Thomas et al, hereafter Thomas.

Claims 60, 79, and 99. Chang discloses, A method, A system, and a computer program product, comprising executing computer-implemented instructions performed by one or more processors for: receiving, by a bill presentment and payment central clearinghouse, information identifying a payee to whom a payor intends to direct payment through the clearinghouse, wherein the payor has not previously activated electronic bill presentment from the payee through the clearinghouse (col. 1, lines 30-48-Background of the Invention); accessing, by the clearinghouse and based on at least a portion of the received information identifying the payee, at least one database containing billing information (col. 8, lines 21-55) and identifying, by the clearinghouse from the accessed billing information, a bill presentment information associated with the payee (col. 8, line 56-col. 9, line 25). Chang failed to disclose, generating, by the



clearinghouse, a notification of the identified bill presentment information associated with the payee; and transmitting, by the clearinghouse to the payor, the generated notification. Thomas discloses, generating, by the clearinghouse, a notification of the identified bill presentment information associated with the payee (col. 12, line 37-col. 13, line 9); and transmitting, by the clearinghouse to the payor, the generated notification (col. 13, lines 4-9, col. 14, line 566-col. 15, line 17). It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the teachings of Thomas in Chang because such an incorporation would allow Chang to have a method and system that provides electronic bill presentment that permits billers to present bills to payors and to transfer funds between a payor and a payee.

Claim 79 Chang further discloses, at least one processor (col. 6, lines 28-35), a communications interface (col. 5, line 50-col. 6, line 8 and lines 28-35), and at least one database (col. 5, lines 43-48).

Claims 61 and 80. Chang failed to disclose, wherein identifying a bill presentment information associated with the payee comprises: matching the at least a portion of the received information identifying the payee to at least a portion of the billing information (col. 15, lines 1-65); and determining, subsequent to the matching, whether a bill presentment information is available in the billing information (col. 19, line 27-col. 20, line 38). It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the teachings of Thomas in Chang because such an incorporation would allow Chang to have a method and system that provides electronic bill presentment that permits billers to present bills to payors and to transfer

funds between a payor and a payee.

Claims 62 and 81. Chang discloses, wherein identifying a bill presentment information associated with the payee comprises identifying an indication that the payee is an electronic biller capable of providing electronic bill presentment to the payor through the clearinghouse (col. 1, lines 18-51).

Claims 63 and 82. Chang discloses, further comprising executing computer-implemented instructions performed by the one or more processors for: receiving, by the clearinghouse from the payor, a request to activate electronic bill presentment of bills for the payor from the payee through the clearinghouse; and initiating activation of electronic bill presentment in response to the received request (col. 2, lines 7-30).

Claims 64 and 83. Chang discloses, wherein initiating activation of electronic bill presentment comprises: transmitting, by the clearinghouse to the payee, a notification of the request to activate electronic bill presentment (col. 2, lines 39-67).

Claim 65. Chang discloses, The method of claim 60, wherein identifying a bill presentment information associated with the payee comprises identifying an indication that an electronic bill from the payee for the payor is available through the clearinghouse (col. 4, lines 13-67).

Claims 66 and 85. Chang discloses, further comprising executing computer-implemented instructions performed by the one or more processors for: receiving, by the clearinghouse from the payor, a request to receive the electronic bill; and transmitting, by the clearinghouse to the payor, the electronic bill (col. 8, lines 4-25).

Claims 67 and 86. Chang discloses, further comprising executing computer-implemented instructions performed by the one or more processors for: transmitting, by the clearinghouse to the payee, a notification of the request to receive the electronic bill (col. 2, lines 7-14).

Claims 68 and 87. Chang discloses, further comprising executing computer-implemented instructions performed by the one or more processors for: receiving, by the clearinghouse from the payor, a request to pay the electronic bill; and remitting, by the clearinghouse to the payee, a payment for the electronic bill (col. 1, lines 41-48) and col. 1, lines 49-51).

Claims 69 and 88. Chang discloses, wherein the information identifying the payee is first information identifying the payee, and further comprising executing computer-implemented instructions performed by the one or more processors for: identifying, by the clearinghouse, second information identifying the payee; and transmitting, by the clearinghouse to the payor, the second information identifying the payee, wherein the notification is transmitted to the payer with the second information identifying the payee (col. 2, lines 1-30).

Claims 70, 89, and 92. Chang discloses, further comprising executing computer-implemented instructions performed by the one or more processors for: storing, by the clearinghouse in a data store, the information identifying the payee (col. 5, line 42-col. 6, line 18), wherein the identification of the bill presentment information occurs one of (i) subsequent to storing the information identifying the payee, or (ii) prior to the storing the information identifying the payee (col. 5, lines 1-42).

Claims 71 and 90. Chang failed to disclose, wherein the billing information includes first bill information, and further comprising executing computer-implemented instructions performed by the one or more processors for: receiving, by the clearinghouse from the payee, second bill information associated with bills of the payee; identifying, by the clearinghouse from at least a portion of the second bill information, an electronic bill of the payee that is available for the payor through the clearinghouse; and transmitting, by the clearinghouse to the payor, a notification of the available electronic bill of the payee. Thomas discloses, wherein the billing information includes first bill information, and further comprising executing computer-implemented instructions performed by the one or more processors for: receiving, by the clearinghouse from the payee, second bill information associated with bills of the payee; identifying, by the clearinghouse from at least a portion of the second bill information, an electronic bill of the payee that is available for the payor through the clearinghouse; and transmitting, by the clearinghouse to the payor, a notification of the available electronic bill of the payee (col. 9, line 15-col. 10, line 57). It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the teachings of Thomas in Chang because such an incorporation would allow Chang to have a method and system that provides electronic bill presentment that permits billers to present bills to payors and to transfer funds between a payor and a payee.

Claims 72 and 91. Chang discloses, wherein the second bill information associated with bills of the payee is received by the clearinghouse subsequent to the receipt of the information identifying the payee (col. 8, lines 21-51).

Claims 73 and 92. Chang discloses, wherein the bill presentment information is a first bill presentment information, wherein the notification is a first notification, and further comprising executing computer-implemented instructions performed by the one or more processors for: determining, by the clearinghouse, information identifying the payor (col. 1, lines 41-48); accessing, by the clearinghouse and based on at least a portion of the determined information identifying the payor, at least one database containing electronic billing information for the payor (col. 5, lines 1-42); and identifying, by the clearinghouse from the accessed electronic billing information for the payor, an electronic bill for the payor that is available to the payor through the clearinghouse (col. 9, line 15-col. 10, line 57); generating, by the clearinghouse based at least in part on the identification of the electronic bill for the payor, a second notification of a second bill presentment information; and transmitting, by the clearinghouse to the payor, the second notification (col. 13, line 4-col. 14, line 67).

Claims 74 and 93. Chang and Thomas failed to disclose, wherein the payee is a first payee, and wherein the electronic bill for the payor is a bill of a second payee different than the first payee. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the payee as the first payee and to have the electronic bill for the payor to be a bill of a second payee and to be different from the first payee because this would be a different identifier to keep the first payee separate from the second payee and assist in the ability to identify each payee's bills.

Claims 75 and 94. Chang discloses, wherein the second bill presentment information comprises an indication that the second payee is an electronic biller capable of

providing electronic bill presentment to the payor through the clearinghouse (col. 6, line 62-col. 7, line 62).

Claims 76 and 95. Chang discloses, wherein the second bill presentment information comprises an indication that the electronic bill from the second payee for the payor is available through the clearinghouse (col. 9, lines 26-67).

Claims 77 and 96. Chang discloses, further comprising executing computer-implemented instructions performed by the one or more processors for: storing an indication of the identified payee in a payee list associated with the payor (col. 6, line 56-col. 7, line 8).

Claims 78 and 97. Chang and Thomas failed to disclose, wherein the payee list comprises multiple payees identified by the payor, and further comprising executing computer-implemented instructions performed by the one or more processors for: transmitting, by the clearinghouse to the payor, a presentation of the payee list, wherein the presentation includes the generated notification of the bill presentment information. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have a presentation of the payee list to include the generated notification of the bill presentment information because this would be a more efficient method of doing business when there are multiple payees identified by a payor.

Claim 87. Chang discloses, The system of claim 85, wherein: the communications interface is further operable to receive, from the payor, a request to pay the electronic bill; and the at least one processor is further operable to direct the remittance, to the payee, of a payment for the electronic bill (col. 5, line 1-col. 6, line 7).

Claim 98. Chang discloses, The system of Claim 97, wherein the presentation includes the bill presentment information (col. 7, lines 45-62).

### **Conclusion**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Ensel et al (US 6,493,685) disclosed billing customers and presenting the bills and payments.

*The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant(s). Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant(s), in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.*

### **Inquiries**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 571-272-6741. The examiner can normally be reached on Monday, Tuesday, and Thursday, 5:30AM-3:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dixon Thomas can be reached on 571-272-6803. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ella Colbert/  
Primary Examiner, Art Unit 3696

May 25, 2009